

REMARKS

An amended title and abstract of the disclosure are provided in response to the Examiner's suggestions appearing on page 2 of the Office Action.

As requested by the Examiner, Applicant hereby provides the following list of co-pending and co-owned applications which also identify the named inventor of the instant application, Peter Nordberg, as an inventor: U.S. Patent Application Serial Nos. 11/995,570 and 12/260,655. The list does not include granted U.S. patents or abandoned U.S. applications naming Peter Nordberg as an inventor.

I. Claim rejections – 35 U.S.C. §102

Claim 8 is rejected under 35 U.S.C. §102(b) in view of each of US 6,313,136 to Amin et al. (the "'136 patent'") and US 6,313,137 to Amin et al. (the "'137 patent'"). Specifically, the Examiner alleges that the compound of claim 8 is disclosed in each of claim 19 of the '136 patent and claim 22 of the '137 patent.

As set forth in M.P.E.P. §2131, anticipation requires more than just a broad and random disclosure:

"The identical invention must be shown in as complete detail as is contained in the... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, i.e., identity of terminology is not required. In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). (Emphasis added)

An inspection of claim 19 of the '136 patent and claim 22 of the '137 patent readily shows that the identical compound of claim 8 is not shown in as complete detail as is contained in the claim. The various substituents R¹-R⁵ and X of claim 19 of the '136 patent and claim 22 of the '137 patent, respectively, are not arranged as required by claim 8 where R¹-R⁴ can only be methyl, R⁵ can only be hydrogen and X can only be nitrogen. Rather, it is possible to arrange the substituents R¹-R⁵ and X of claim 19 of the '136 patent and claim 22 of the '137 patent in any number of ways without showing the claimed compound in as complete detail as is contained in claim 8.

For all of the foregoing reasons, it is respectfully submitted that the '136 and '137 patents do not anticipate claim 8. Withdrawal of the §102 rejections is requested.

II. Claim rejections – 35 U.S.C. §103 and Obviousness-type double patenting

Claims 1-3, 5, 7 and 8 are rejected under 35 U.S.C. §103(a) as being unpatentable over the '137 patent. The same claims are rejected for obviousness-type double patenting in view of the '137 patent.

As acknowledged by the Examiner on page 2 of the Office Action having a mail date of 3 December 2008, Applicant submitted a Declaration of Peter Nordberg under 37 C.F.R. §1.132, filed 22 August 2008, showing an unexpected dissolution behavior of the claimed compound as compared to Example 1.3 of the '137 patent. The Declaration was sufficient warranting withdrawal of a §103 rejection in view of the '137 patent.

Applicant relies on the Declaration of Peter Nordberg of record and the prosecution history acknowledging that the Declaration demonstrates the nonobviousness of the claimed invention in comparison to the '137 patent. Accordingly, it is respectfully submitted that the claimed invention is neither obvious nor an obvious modification in view of the '137 patent.

For all of the foregoing reasons, the §103 and obviousness-type double patenting rejections are moot and should be withdrawn.

CONCLUSION

Applicant has made a good faith attempt to the Office Action. Claims 1-3, 5, 7 and 8 are pending and, for the reasons set forth herein, are in condition for allowance, which action is earnestly solicited.

Authorization is hereby given to charge any fee due in connection with this communication to Deposit Account No. 23-1703.

Dated: 29 July 2009

Respectfully submitted,

/John M. Genova

John M. Genova

Reg. No. 32,224

Customer No. 07470

Direct Line: (212) 819-8832